

REMARKS

Claims 1-19 are pending in this application. Claims 4, 5, 14-16, 18, and 19 have been withdrawn from prosecution based on a restriction requirement. Claims 1-3, 6-13, and 17 were rejected by the Examiner. In view of the following remarks, Applicants respectfully request reconsideration of the application.

The Examiner objected to claim 4 as being informal for including the incorrect identifier in the Amendment filed on September 21, 2005. Applicants submit this Response with the proper claim identifier.

Claims 1, 2, 6, 8, 13, and 17 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. patent number 6,035,757 to Caluori ("Caluori") in view of PCT application number WO 99/02310 to Van Osenbruggen ("Van Osenbruggen") and U.S. patent number 4,648,610 to Hegyi ("Hegyi"). Applicants respectfully traverse.

Obviousness requires some suggestion or motivation to combine the references used to establish a *prima facia* case. One skilled in the art would not have been motivated to combine Caluori with Van Osenbruggen and Hegyi without improperly referring to the claimed invention in hindsight. Accordingly, the Examiner has not established a *prima facia* case of obviousness.

Caluori discloses a laser that is mounted on the rotor of a saw and is powered from a battery located on the rotor. Van Osenbruggen discloses a plurality of embodiments that feature tools with lights, although none of the lights are located on a rotating component of the tool, nor does Van Osenbruggen suggest that this is possible.

Hegyi discloses a light emitting roller skate wheel. Hegyi includes a permanent magnet (3) that is attached to a mounting means (4) on the truck (7) of a roller skate, and a wheel that rotates about the truck with a bearing (13). The wheel additionally includes a coil (2) of wire about a core (1) embedded within the wheel and electrically connected to an LED (5). When the wheel rotates, the coil of wire rotates relative to the magnet and periodically induces a current in the wire to power the LED when the coil rotates past the magnet.

Although Hegyi discloses a light on a rotating member that is powered from current generated within the rotating member, the combination of Caluori, Van

Osenbruggen, and Hegyi is improper because Hegyi is not analogous to the claimed invention and therefore cannot be properly combined with Caluori and Van Osenbruggen to reject the claims in this application. See MPEP 2141.01(a).

In order for a reference to be properly combined in an obviousness rejection, the reference must either be in the same field of endeavor as the claims, or, if not, then the reference must be reasonably pertinent to the particular problem with which the claimed invention is concerned. See *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); MPEP 2141.01(a)(l). Applicant respectfully submits that the combination of Hegyi with the other cited references is improper because Hegyi is not analogous to the claimed inventions.

Specifically, as discussed above, Hegyi is directed to a roller skate wheel with a light that illuminates when the roller skate wheel is rotated. Applicant submits that one of skill in the art of cutting tools such as saws would not rationally consider Hegyi to be within the claimed endeavor. Cutting tools and saws are generally used by those of skill in the art to cut workpieces into specific sizes and along predetermined lines. In contrast, the roller skates are used for transportation and for recreational exercise.

Similarly, one of ordinary skill in the art would not consider the Hegyi roller skate to be reasonably pertinent to solve the problem that the claimed invention is concerned with. Specifically, the claimed invention is concerned with the problem of precisely cutting a workpiece aided with a laser light provided in the rotating portion of the saw. In contrast, the Hegyi roller skate is concerned with providing a roller skate wheel that includes a light that flickers when the wheel rotates, for the aesthetic qualities of the light and for identifying the roller skate user in low light situations. Neither of these potential uses are reasonably related to the problem the claimed invention addresses, and accordingly, Applicant submits that the Hegyi roller skate could not have been considered to be related without the improper benefit of hindsight.

Accordingly, because Hegyi is not from the same field of endeavor as the claimed invention and one of ordinary skill in the art would not reasonably consider a roller skate to be pertinent to the problem that the claimed invention is concerned with, Hegyi was improperly combined with Caluori and Van Osenbruggen to reject claims 1-3, 6-13, and 17. Accordingly, the Examiner has not provided a *prima facia* case of

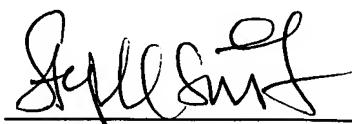
obviousness because the Examiner has not provided prior art analogous prior art references that disclose every limitation of the current claims.

Applicants respectfully assert that the combination of Caluori and Van Osenbruggen does not disclose or suggest all of the limitations of claims 1, 8, and 17. Specifically, this combination does not disclose "a circuit electrically connected to the laser ... wherein electric current to power the laser is generated on the spindle and the spindle has no electrical connections with the non-rotating portion of the saw" as in claim 1. Similarly, the combination does not disclose "a generator electrically connected to the light source ... the generator includes a rotor ... wherein the rotor has no electrical connections with a non-rotating portion of the saw" as in claim 8, and "a generator electrically connected to the light source ... having a permanent magnet secured to a fixed guard and a coil rotated by the spindle, wherein the spindle has no electrical connections with a non-rotating portion of the saw" as in claim 17. Moreover, there is no analogous prior art of record in this case that discloses or suggests these limitations.

Because the Examiner has not established a *prima facia* case of obviousness, Applicants respectfully request that the rejection of claims 1-3, 6-13, and 17 be withdrawn.

Claims 1-3, 6-13, and 17 are patentable. Applicants respectfully request the Examiner grant early allowance of this application. The Examiner is invited to contact the undersigned attorney for the Applicants via telephone if such communication would expedite this application.

Respectfully submitted,



Stephen C. Smith
Registration No. 56,250
Attorney for Applicants

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200